

## REMARKS

Claims 1 through 5, 7, 8 and 10 are pending in this Application, of which claims 3 through 5, 7, 8 and 9 through 10 stand withdrawn from consideration.

Claims 1, 3 through 5, 7, 8, 10 and 11 have been amended. Care has been exercised to avoid the introduction of new matter. Applicants note that limitations from claim 2 have been incorporated into claim 1, claim 2 cancelled, and appropriate changes made in the remaining claims. Applicants submit that the present Amendment does not generate any new matter issue.

### Specification

The Examiner asserted that the spacing of words in the specification in various places, such as at page 1, line 17 and 18, renders it difficult to read, particularly since there is no spacing between certain words. The Examiner required a new Application.

Submitted herewith as Exhibit A is a copy of the specification as filed with proper spacing, as requested by the Examiner.

**Claims 1 and 2 were rejected under 35 U.S.C. §103 for obviousness predicated upon Roba.**

This rejection is traversed.

There is a fundamental difference between the claimed method and Roba's method that undermines the ultimate legal conclusion of obviousness under 35 U.S.C. §103. Specifically, the method defined in independent claim 1 comprises a sequence of manipulative steps, including the manipulative step of changing the chromatic dispersion along the longitudinal direction by changing the gas flow rate or gas composition supplied to the periphery of the lower end portion of the optical fiber preform so as to achieve the actual drawing tension changes as given changes

along the longitudinal direction. This manipulative step is neither disclosed nor suggested by Roba. Applicants would stress that the above argued step recited in claim 1 is a manipulative step performed to achieve a particular objective - not an intended function but a required function achieved by the recited manipulative steps. In other words, if a manipulative step is performed and the function recited in the claim is not achieved, then that manipulative step does not satisfy the requirements of claim 1.

Based upon the foregoing, Applicants submit that one having ordinary skill in the art would not have found the claimed invention as a whole obvious within the meaning of 35 U.S.C. §103 predicated upon Roba. Applicants, therefore, submit that the imposed rejection of claims 1 and 2 under 35 U.S.C. §103 for obviousness predicated upon Roba is not factually or legally viable and, hence, solicit withdrawal thereof.

#### **The Non-elected Invention**

Applicants solicit rejoinder of non-elected claims 3 through 5 based upon the allowability of claim 1.

Based upon the foregoing it should be apparent that the imposed rejection has been overcome and that claims 1 and 3 through 5 are in condition for immediate allowance.

Favorable consideration is, therefore, respectfully solicited.

09/734,205

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Arthur J. Steiner  
Registration No. 26,106

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 AJS:bjs:ntb  
Facsimile: (202) 756-8087  
**Date: January 15, 2004**